

REMARKS

In the Office Action dated July 20, 2009, claims 16, 18 to 21, 23 to 26, and 28 to 79 were restricted under 35 U.S.C. 121 and 372 into 22 Groups (Groups I through XXII) as defined at pages 2-4 of the Office Action.

Upon entry of the present amendments, claims 23 to 26, 40 to 45, 73, 74, and 78 to 153 will be pending in this application. Claims 16, 18 to 21, 28 to 39, 46 to 72, and 75 to 77 are being cancelled without prejudice or disclaimer. The Applicants reserve the right to pursue the subject matter of the cancelled claims in one or more timely filed continuation, continuation-in-part, or divisional applications.

Claim 23 has been amended to add a proviso that excludes compounds having R2 and R3 independently selected from phenyl and substituted phenyl, wherein (a) R2 and R3 have phenyl at the same time or (b) R2 and R3 have the same substituents on the same position. For clarity, claim 23 was also amended to remove from the list of compounds included in the original proviso those compounds that would be encompassed by the new proviso mentioned above, and to remove the original proviso at the very end of the claim which is redundant in light of the new proviso. Support for the new proviso can be found at page 16, lines 28 to 31 of the specification as filed.

Claim 24 has been amended to correct a typographical error, specifically to replace the second occurrence of substituent R6 with R7 in general formula III.

Dependent claims 73 and 78 have been amended to delete compounds that are encompassed by the new proviso added into independent claim 23 described above.

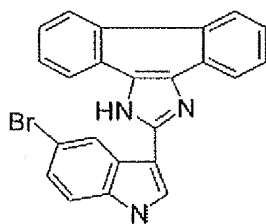
New claims 80 to 99 are directed to an anti-microbial composition comprising an effective amount of one or more of the claimed compounds. New claims 100 to 107, 114 to 117, 122, 123, 126 to 129, and 140 to 147 are directed to a method of inhibiting the growth and/or proliferation of a microbial cell comprising contacting said microbial cell with an effective amount of one or more of the claimed compounds. New claims 108 to 113, 118 to 121, 124, 125, 130 to 139, and 148 to 153 are directed to a method for the treatment or prevention of a microbial infection in an animal in need thereof comprising administering to

said animal an effective amount of one or more of the claimed compounds. Support for the new claims can be found throughout the specification as filed. Applicants assert that no new matter has been added by way of these amendments.

Election/Restriction

The Applicants elect, with traverse, Group XX (claims 21, 25, 26, 39, 42, 43, 45, 46, 49-51, 7072, 74 and 79, all in part), which has been defined by the Examiner as being drawn to compounds and compositions wherein R2 and R3 together form a phenanthrene ring system and wherein R1 is unsubstituted or substituted indolyl.

The Applicants further elect with traverse the following species:



Claims 25, 26, 42, 43, 45, 74 and 79, and new claims 81, 83, 85, 87, 89, 91, 93, 95, 98, 99, 101, 103, 105, 107, 109, 111, 113, 115, 117, 119, 121, 123, 125, 127, 129, 131, 133, 135, 137, 139, 141, 143, 145, 147, 149, 151 and 153, submitted herewith, encompass the elected species.

Applicants note that new claim 81 corresponds to claim 21, as it relates to elected Group XX and that, as such, claim 81 and claims dependent thereon also belong to elected Group XX. Claim 21 has been cancelled without prejudice or disclaimer.

The Examiner alleged that the inventions listed as Groups I-XXII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. In particular, the Examiner has cited Mjalli *et al.* (US 5700826) ("Mjalli"), Bhaduri *et al.* (*Indian J. Chem.*, 1966, 4:414-420) ("Bhaduri"), and CAS Registry Numbers 309285-51-6, 330449-52-0, 332148-67-1 and 404904-57-0 ("CAS Registry Numbers") and stated that these references either anticipate or

render obvious the compounds as claimed and hence, the instant claims do not have a special technical feature.

Without conceding to the correctness of the Examiner's position, but in order to expedite prosecution of the instant application, Applicants have cancelled claims 16, 18 to 21, 28 to 39, 46 to 72, and 75 to 77, and have amended claims 23, 73 and 78, to exclude compounds having R2 and R3 independently selected from phenyl and substituted phenyl, wherein (a) R2 and R3 have phenyl at the same time or (b) R2 and R3 have the same substituents on the same position.

Applicants assert that claims 23 to 26, 40 to 45, 73, 74, and 78 to 153 are linked by a common inventive concept in that these claims all relate to compounds having the same core structure, which is indolyl imidazole moiety having aromatic rings attached to the 4- and 5- position of the imidazole ring, which groups can be attached either directly or through a fused ring system. As described in the instant specification, the compounds as defined in the amended claims not only share a common structural feature, but also share similar biochemical properties in that they are capable of inhibiting microbial cell growth or proliferation. As such, Applicants assert that the instantly claimed subject matter considered as a whole, is linked by a common technical feature, as required by PCT Rule 13.2, and the compounds, compositions and methods of using the compounds are thus linked by a single general inventive concept that unifies claims 23 to 26, 40 to 45, 73, 74, and 78 to 153.

Moreover, Applicants assert that the compounds as claimed are not anticipated nor rendered obvious by the prior art. Firstly, Applicants assert that the compounds described in Mjalli, Bhaduri and the CAS Registry Numbers are not encompassed by the genus of compounds defined in instant claims 23 to 26, 73, 74, 78 and 79. In particular, these references fail to disclose compounds which possess the common structural feature of an indolyl imidazole moiety having aromatic rings attached to the 4- and 5- position of the imidazole ring, which groups can be attached either directly or through a fused ring system, wherein when R2 and R3 are independently selected from phenyl and substituted phenyl, then (a) R2 and R3 are not phenyl at the same time or (b) R2 and R3 do not have the same substituents on the same position (see new proviso added). Neither do Mjalli, Bhaduri or the

CAS Registry Numbers provide any teaching or suggestion of this common structural feature, or that compounds sharing this structure would have anti-microbial activity. As such, Applicants assert that the invention as claimed in claims 23 to 26, 40 to 45, 73, 74, and 78 to 153 is novel and inventive in view of the disclosure of Mjalli, Bhaduri, and the CAS Registry Numbers and that these claims should therefore all be examined together in one application.

Furthermore, Applicants assert that the claims submitted herewith meet the requirement under PCT Rule 13.1 and 13.2, and 37 CFR 1.475 for belonging to permissible combinations of different categories. In this regard, the Examiner is also directed to Section (e)(i) of Annex B of the PCT Administrative Instructions, which permits, for the purposes of determining unity of invention under Rule 13.2 "claims of different categories in the same international application: (i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of said product." [Emphasis added].

Applicants further assert that the claims 23 to 26, 40 to 45, 73, 74, and 78 to 153 are connected by a single, searchable unifying relationship as discussed above, i.e., all claims relate to compounds having the same core structure of an indolyl imidazole moiety having aromatic rings attached to the 4- and 5- position of the imidazole ring, which groups can be attached either directly or through a fused ring system. In view of this single, searchable unifying relationship, Applicants assert that the Examiner would not be seriously burdened by searching and examining all these claims together in a single application.

In summary, Applicants assert that not only has the requirement of unity of invention as defined under PCT Rules 13.1 and 13.2 been met in that claims 23 to 26, 40 to 45, 73, 74, and 78 to 153 are linked by a special technical feature and belong to a permissible combination of different categories, but also that the claims are connected by a single, searchable unifying relationship as noted above and that the Examiner would not, therefore, be seriously burdened by searching and examining all the claims in a single application. Accordingly, Applicants respectfully request reconsideration and withdrawal of the restriction and that claims 23 to 26, 40 to 45, 73, 74, and 78 to 153, submitted herewith, be examined together in the present application.

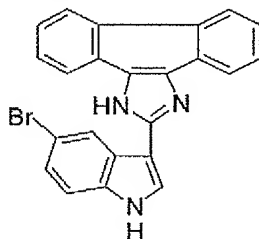
In the event the Examiner does not find the above arguments persuasive, and solely in order to expedite prosecution of the instant application, Applicants elect with traverse Group XX.

Species Election

The Examiner stated that claims 16, 18 to 21, 23 to 26 and 28 to 79 are generic, alleging that they encompass the following patently distinct species: Compound numbers 1 to 84. The Examiner alleged that these species have mutually exclusive characteristics and are not obvious variants of each other based on the record. According to the Examiner, the species require a different field of search and/or the prior art applicable to one species would not likely be applicable to another species and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph. The Examiner has, therefore, required that the Applicant elect a single species for further prosecution.

Applicants respectfully traverse the Examiner's restriction, in particular, for the compounds defined in claims 23 to 26, 73, 74, 78, and 79, currently on file. As outlined above, Applicants maintain that the compounds recited in the pending claims 23 to 26, 73, 74, 78 and 79 share a common core structure of an indolyl imidazole moiety having aromatic rings attached to the 4 and 5- position of the imidazole ring, which groups can be attached either directly or through a fused ring system. As such, Applicants assert that claims 23 to 26, 73, 74, 78 and 79 are all linked by a single, searchable unifying relationship and that there would thus be no serious burden on the Examiner to search and examine claims 23 to 26, 40 to 45, 73, 74, and 78 to 153, submitted herewith, in a single application.

In the event that the Examiner finds the above arguments are not persuasive, Applicants elect with traverse the following species:



Additional Species Election

The Examiner also required an election of a single disease/condition and an election of a specific microbial cell, in the event Applicants elect one of Groups I to XI to be examined on the merits. Applicants are not electing one of Groups 1 to XI to be examined on the merits. Accordingly, the conditional requirement for additional species election is moot.

Other Matters

The Examiner has indicated that in order to retain the right to rejoinder for the unelected process claims, the process claims must be amended during prosecution to require all the limitations of the product claims. In this regard, Applicants point out that new claims 100 to 101 and 108 to 109 are respectively directed to a method of inhibiting the growth and/or proliferation of a microbial cell and a method for the treatment or prevention of a microbial infection, refer directly to the compounds of currently pending product claims 23 or 25. Accordingly, should the Examiner maintain the restriction between product and process claims, Applicants submit that new method claims 100 to 153 should be considered for rejoinder once the currently pending product claims 23 to 26, 73, 74, 78, and 79 are found allowable.

Petition for a One-Month Extension of Time

Applicants hereby petition for a one-month extension of time in which to respond to the Office Action of July 20, 2009, which permitted one month for reply. The Commissioner is authorized to charge the requisite extension fee of \$65.00, and any necessary fees for this submission, to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Applicants request examination of the merits of the present application. In the event that any fees are required for the filing of this document, the Commissioner is authorized to

MBM File No. 335-148US
McAndrews Ref. 16526US01
U.S Patent Application No. 10/525,690

charge our Deposit Account No. 13-0017 in the name of McAndrews, Held & Malloy, Ltd.

Respectfully submitted

Date: September 21, 2009

/Michael B. Harlin/

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